

REMARKS

Applicant responds to the Office Action of January 23, 2003, in which claims 1-29 and 32-95 are pending in the application. Claims 53-74 have been withdrawn from consideration. Applicant requests entry of the foregoing amendment in order to present the application in better form on appeal. Upon entry of the foregoing amendment, claims 53-74 are cancelled.

Applicant has filed herewith a Notice of Appeal in response to the Final Office Action of January 23, 2003.

Rejection of Claims 1-26 under 35 U.S.C. §112

Claims 1-26 have been rejected under 35 U.S.C. §112, first paragraph, as being based on a disclosure that is not enabling. The Examiner contends that it seems unlikely that a recessed route, lined with non-adhesive material would collapse and adhere to the facestock, while pulling the adhesive away from the substrate to form air egress routes at the interface of adhesive layer and substrate. The Examiner further requests a declaration from a disinterested person to show the feasibility of how a generally deformable not fully cured pressure sensitive adhesive can be pulled away from the substrate to form air egress routes by the force generated by collapsing the non-adhesive material.

Applicant respectfully submits that the Examiner has not established a prima facie case of nonenablement, and further, that the Examiner has mischaracterized the invention of claim 1. Specifically the Examiner has stated that the adhesive is a "not fully cured pressure sensitive adhesive" and that the non-adhesive material is collapsed. The adhesive of claim 1 is not claimed as a pressure sensitive adhesive, nor is it claimed as "not fully cured". It appears the Examiner has read those limitations into claim 1 without any support. Furthermore, as described in the specification at page 15 with reference to Figures 3a-3c, it is the channels 35 created by the printing process that are collapsed, not the non-adhesive material forms themselves that are collapsed. Additionally, nowhere in the specification does Applicant state that the non-adhesive material forms are adhered to the facestock.

By law, a patent application is presumptively enabled when filed. "When rejecting a claim under the enablement requirement of section 112, the PTO bears an initial burden of setting forth a reasonable explanation as to why it believes that the scope of protection by that claim is not adequately enabled by the description of the invention provided in the specification of the application; this includes, of course, providing sufficient reason for doubting any assertions in the specification as to the scope of the enablement." *In re Wright*, 999 F.2d 1557, 1561-62, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993). The Examiner has based his reasons for doubting the accuracy of the statements contained in the specification on a mischaracterization of the invention and further has failed to support the rejection with properly reasoned and supported statements explaining any failure to comply with §112. Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 1-26 based on 35 U.S.C. §112, first paragraph.

Rejection of Claims 27-29 and 32-52 under 35 U.S.C. §112

Claims 27-29 and 32-52 have been rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, the Examiner has stated that since known pressure sensitive adhesives are viscoelastic materials, i.e., not permanently deformable, the absence of such suitable permanently deformable adhesives in the disclosure renders claim 27 in excess of its provided enablement.

Applicant respectfully submits that the Examiner has mischaracterized the adhesive article of claim 27-29 and 32-52. Specifically, the Examiner has stated that claim 27 requires a permanently deformable pressure sensitive adhesive, and that all pressure sensitive adhesive are viscoelastic, and therefore not permanently deformable. However, claim 27 is not limited to pressure sensitive adhesives. Applicant has included in claim 10 a recitation that the adhesive layer comprises a pressure sensitive adhesive and has included in claim 11 the recitation that the adhesive layer comprises a heat-activated adhesive. It would be apparent to those skilled in the art that the size of the non-adhesive

material forms needed and the depth to which they are embedded may exceed the depth and size of the resulting channels created, depending on the chemistry and rheology of the adhesive chosen, as well as the non-adhesive material chosen. Furthermore, it would be apparent to one skilled in the art that the duration of the channels formed need not be permanent, as air egress may be desired for only limited times, i.e., upon application of the adhesive article to the substrate. Because the Examiner has based his reasons for doubting the accuracy of the statements contained in the specification on a mischaracterization of the invention and further has failed to support the rejection with properly reasoned and supported statements explaining any failure to comply with §112, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 27-29 and 32-52 based on 35 U.S.C. §112, first paragraph.

In view of the foregoing amendment and remarks, Applicant respectfully submits that the Examiner's rejections have been overcome and respectfully requests allowance of claims 1-29, 32-52.

Respectfully submitted,  
RENNER, OTTO, BOISSELLE & SKLAR, LLP

By Heidi A. Boehlefeld  
Heidi A. Boehlefeld  
Reg. No. 34,296

1621 Euclid Avenue  
Nineteenth Floor  
Cleveland, Ohio 44115  
(216) 621-1113